

REMARKS/ARGUMENTS

Claims 1, 2, 4-7 and 10-20 are active.

No amendments are submitted.

The claims of this application are to a glass strand coated with an electrically conducting composition, which includes certain percentages of a film-forming agent, one or more of a plasticizing agent, surface-active agent and/or dispersing agent and electrically conducting particles, such as graphite or carbon black. As discussed in the specification in the paragraph bridging pages 5-6 the specific % range of film forming agents such as polyvinylpyrrolidones are chosen at that % value to impart advantageous properties.

As explained in the background of the application in prior electrically conducting coating compositions the amount of conducting particles was relatively low achieving only low levels of electrical conductivity. Thus, the invention sought to improve the electrical conductivity by enabling the use of higher amounts of electrically conducting particles and optionally including doping agents to increase the conductivity (see page 9, starting at line 19 and pages 2-3).

The Examiner has raised a new ground of rejection to allege that the claims would have been obvious in view of newly cited U.S. patent no. 6,419,918 to Novich in view of previously cited U.S. 6,086,791 to Miller. The rejection mirrors the earlier rejections but now the Examiner cites to Novich to generally teach the claimed composition (Novich teaches other film formers) but not 44 to 75% of electrically conducting particles wherein at least 15% of the particles have a flake or needle shape as recited in Claim 1. Therefore, the Examiner again relies on Miller as before (see page 3 of the Official Action).

Miller in Table 1 (see page 5, 1st paragraph of the Official Action) describes the Printex XE carbon black material as having a flake-like structure is only present in an amount of 3% (noting that the values of the composition in Table 1 are in grams not percentages).

This is insufficient teachings to support the Examiner's contention of obviousness.

Furthermore, Applicants again emphasize the fact that Miller describes a paint (col. 2, line 66) to be applied on various substrates, for example floors, walls, ceilings, roof, gutter, outdoor structures, home/commercial appliances (col. 3, lines 1-21). Miller does not provide any salient teachings as to coatings on glass strands or glass strand structures according to present Claim 1. Thus, reliance on Miller is improper and based on hindsight because Miller has nothing to do with electrically conducting coating compositions on glass strands. See *In re Klein*, 647 F.3d 1343 (Fed. Cir. 2011) "A reference qualifies as prior art for an obviousness determination under § 103 only when it is analogous to the claimed invention. *Innovention Toys, LLC, v. MGA Entertainment, Inc.*, No. 2010-1290, slip op. at 12 (Fed. Cir. Mar. 21, 2011); *In re Bigio*, 381 F.3d 1320, 1325 (Fed. Cir. 2004); *In re Clay*, 966 F.2d 656, 658 (Fed. Cir. 1992). "Two separate tests define the scope of analogous prior art: (1) whether the art is from the same field of endeavor, regardless of the problem addressed and, (2) if the reference is not within the field of the inventor's endeavor, whether the reference still is reasonably pertinent to the particular problem with which the inventor is involved." *Bigio*, at 1325.

In Miller's examples, the paint is applied on a glass pan or dish, or a metal pan. Furthermore, Miller's paint includes a large quantity of solvent (xylene) contrary to the electrically conducting coating composition according to Claim 9 which is aqueous. Therefore, Applicants find no basis to argue that one in the field of electrically conducting coating compositions on glass strands would look to Miller for any guidance whatsoever and as such the underlying presumption of the rejection is flawed.

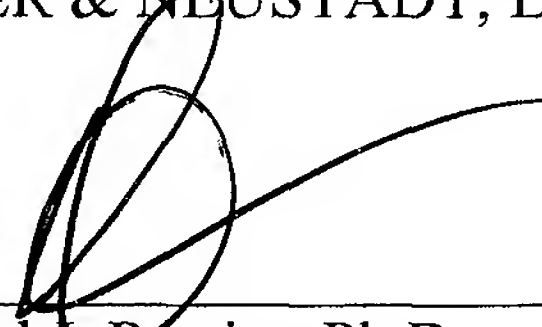
Furthermore, the problem Novich et al. intend to solve is to improve the "wet-through" and the "wet-out" properties (col. 2, lines 19-24). The proposed solution is to coat the fiber strand with a coating comprising a plurality of particles 18 that adhere to the outer

surface of the fibers and provide interstitial spaces. The particles are preferably "discrete" particles that do not tend to coalesce or combine to form continuous films under conventional processing conditions (col. 8, lines 24-36). The coating on fiber strands facilitate thermal conduction along coated surface of the glass fibers which is desired when the said fibers are used to produce electronic circuit board (col. 4, lines 44-53). Thus, there would have been no motivation to replace such particles with particles wherein at least 15% of the particles have a flake or needle shape as recited in Claim 1 from Miller, even assuming that Miller provided salient teachings to the claimed invention.

Withdrawal of the rejection is requested.

Respectfully submitted,

OBLON, SPIVAK, McCLELLAND,
MAIER & NEUSTADT, L.L.P.

A handwritten signature in black ink, appearing to read 'Daniel J. Pereira', is written over a horizontal line.

Daniel J. Pereira, Ph.D.
Attorney of Record
Registration No. 45,518

Customer Number

22850

Tel: (703) 413-3000
Fax: (703) 413 -2220
(OSMMN 07/09)